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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/982,145

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Nick Nassiri

7545

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EXAMINER

NASH, LASHANYA RENEE

ART UNIT

PAPER NUMBER

2153

MAIL DATE

DELIVERY MODE

06/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/982,145	<b>Applicant(s)</b> NASSIRI, NICK	
	<b>Examiner</b> LASHANYA R. NASH	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-48, 50-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This action is in response to amendment filed 17 March 2008. Claims 1-45 and 49 are cancelled. Claims 46-48, and 50-52 are presented for further consideration.

### ***Response to Arguments***

Applicant's arguments filed, with respect to claims 46-48 and 50-52 have been fully considered, but are not persuasive.

In considering the Applicant's arguments the following arguments remarks are noted:

- (I) Applicant contends that the method of delivery of email by the independent third party to the intended recipient in the pending application is not the same as disclosed by Epstein.
- (II) Applicant contends that the method of identifying the e-mail source of the re-mailer and the email address of the intended recipient in the pending application is not the same as disclosed by Epstein.
- (III) Applicant contends that Epstein does not disclose method of retrieval of the email by the intended recipient in the pending application.
- (IV) Applicant contends that Epstein does not disclose the method of posting a reply by the intended recipient in the pending application.

In considering (I) thru (IV), Applicant contends the method of delivery of email by the independent third party to the intended recipient in the pending application is not the

same as disclosed by Epstein. Examiner respectfully disagrees. Examiner asserts that Epstein was cited so as to disclose the convention operation of anonymous re-mailer systems to be well known in the art at the time of the invention, and not to teach the specific embodiments of Epstein's invention. More specifically, the portion of Epstein that is cited in the rejection as teaching the corresponding claimed features is Epstein's **description of related art** and not the description of the invention of Epstein itself.

Examiner notes the differentiation between the embodiments of Epstein's invention as expressed in detail by Applicant. However, Examiner notes that **disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments**. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In this case, the broader disclosure or nonpreferred embodiment that is relied upon as evidencing claimed features is Epstein's **description of related art**. **Therefore, Applicant's arguments that pertain to establishing a patentable distinction over the preferred embodiments of Epstein, or rather the particular functionality (i.e. public key or PKI) of the anonymous query system of Epstein, are not relevant.** Examiner again reiterates, that features of Applicant's invention taught by Epstein are expressly divulged in a broad disclosure of the related art (column 1, lines 45-62) and not the description of the preferred embodiments of Epstein's particular invention.

Examiner asserts that Applicant has presented no arguments regarding the cited portion

of Epstein failing to teach claimed features and subsequently Examiner maintains the rejections as set forth below in the Office action.

Examiner also finds it important to note, that Epstein expressly discloses that the identity of the originator of an email is anonymous to the final recipient, but known to the provider (i.e. re-mailer retains the source address of the message, column 1, lines 45-62). Also, that use of a private key is not the sole means by which a reply/response is posted to be retrieved by an intended recipient (i.e. reply is forwarded to the source address retained by the remailer; column 1, lines 58-63).

Examiner further notes that the remainder of Applicant's arguments presented regarding the rejections over Sykes were addresses in the Office action mailed 14 April 2006. However, Examiner finds it important to presently note that in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Applicant presents arguments regarding features that are not taught by the individual reference of Sykes (i.e. verification record in the form of a digital certificate). However, it has been clearly addressed in the response to arguments in the aforementioned Office action (2006) and established in the rejection of claims that these limitations are taught by the combination of Sykes and Byrd.

Additionally, Applicant's argues that Sykes fails to disclose verification of the content of the email message in a manner similar to Applicant's invention. Specifically, Applicant argues that this distinction is based on Applicant's disclosure that the contents of the original message are contained in the verification record along with the time and date of submission and delivery. However, Examiner asserts that the claims recite a broad limitation regarding the verification record, "the processing unit creating a confirmation record", thus merely stating that a confirmation record is created without any additional limitations which specify the contents of this aforementioned record. Similarly, Examiner asserts that the claims recite a broad limitation regarding content verification, "the processing unit verifying the content of the electronic message", thus merely stating that an email is verified without any additional limitations which specify the particular manner that this verification is accomplished. **While Applicant's remarks discuss in detail the verification process of email messages as disclosed in the specification, the features upon which applicant relies to support an alleged distinction are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 46-48, and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sykes, Jr. (US Patent Application Publication 2002/0129108), in view of Byrd (US Patent 6,081,899) and Epstein (US Patent 6,023,510), hereinafter referred to as Sykes, Byrd, and Epstein respectively.**

In reference to claim 46, Sykes discloses a method and system for archiving, registering, and verifying electronic communications transmitted between clients and recipients via a network (i.e. Internet), (abstract and paragraph [0004], lines 1-13). Specifically, Sykes discloses the third party archiving and verification system to comprise:

- The method for registering and certifying an electronic message, the method, (abstract; paragraph [0004], lines 1-13; and paragraph [0038], line 1 to paragraph [0040], line 17), comprising the steps of:
- A client accessing a website and establishing a registration account, (paragraph [0048]; Figures 4-22);
- A processing unit (i.e. third party archiving and verification server; paragraph [0038]) accepting the registration account (i.e. server of provider web page; paragraph [0048]);
- The processing unit assigning a code (i.e. account ID) to the registration account of the client, (paragraph [0048], line 1 to paragraph [0049], line 16 and Figure 4); and

- The client selecting a service request (i.e. user selects confirm email; paragraph [0062], lines 1-4; Figure 21);
- The processing unit receiving the client's service request, (i.e. system receives email; paragraph [0062], lines 4-7; Figure 21);
- The processing unit sending the electronic email message to the intended recipient as identified by the client in the registration account, (i.e. system delivers the email to recipients inbox; paragraph [0062], lines 8-19; Figure 22)
- The processing unit confirming the date the electronic message was received by the intended recipient (i.e. date and time stamp of message read by recipient; paragraph [0065], lines 11-13; Figure 27-“Date: September 5, 2001 Time: 05:22:01 PM”);
- The processing recipient choosing whether or not to post a reply for the client with the processing unit, the processing unit accepting the reply, if posted (paragraph [0043], line 1 to paragraph [0044], line 17; Figure 26);
- The processing unit creating a confirmation record (i.e. message table entry) (paragraph [0038], line 1 to [0047], line 12; paragraph [0059], line 1 to paragraph [0061], line 8; and paragraph [0065], lines 9-13; Figure 26).

Although Sykes discloses substantial features of the claimed invention, the reference fails to show the processing unit creating a digital certificate containing the information of the confirmation of the confirmation record; the processing unit archiving the digital certificate information; and the processing unit sending the client the digital certificate. Nonetheless, digital certificates were well known in the art at the time of the invention,



as further evidenced by Byrd. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to accordingly modify the method as disclosed by Sykes.

In an analogous art, Byrd discloses a method for validating electronic messages in order to prevent tampering, (abstract). Byrd further discloses the message validating method comprises a processing unit creating a digital certificate containing the information of the confirmation of the confirmation record (i.e. user's digital certificate issued by authority; column 3, lines 35-48; Figure 3-items 401, 407); the processing unit archiving the digital certificate information (i.e. database stores digital certificate; column 3, lines 35-58); and the processing unit sending the client the digital certificate (i.e. return receipt; Figure 5-item 505; column 4, lines 19-22). One of ordinary skill in the art would have been motivated to implement the digital certificate in the aforementioned method of Sykes, so as to further validate transmission by encoding electronic messages for protection against tampering of content (Byrd column 2, lines 19-33). Although Sykes and Byrd disclose substantial features of the claimed invention, the reference fails to explicitly disclose the method comprising: a service request further comprising that the client's identity be withheld from the intended recipient; the processing unit resending the electronic message to the intended recipient as identified by the client in the registration account; the processing unit notifying the intended recipient that the electronic message has been sent on behalf of the client by the processing unit. Nonetheless, these features would have been obvious modifications to

the aforementioned method, as disclosed by Sykes and Byrd, for one of ordinary skill in the art at the time of the invention, as further evidenced by Epstein.

In an analogous art, Epstein discloses a method of secure and anonymous electronic messaging via a public network (abstract). Epstein expressly discloses the well know use of an anonymous remailer which provides: service request comprising that the client's identity be withheld from the intended recipient; the processing unit resending the electronic message to the intended recipient as identified by the client in the registration account; the processing unit notifying the intended recipient that the electronic message has been sent on behalf of the client by the processing unit (column 1, lines 45-62). These modifications to the aforementioned method, as disclosed by Sykes and Byrd, would have been obvious to one of ordinary skill in the art because one would have been so motivated to facilitate "bi-directional e-mail communication over a network without compromising the sender's identify", and thereby increasing user privacy, (Gabber column 2, lines 1-5).

In reference to claim 50, Sykes discloses a method and system for archiving, registering, and verifying electronic communications transmitted between clients and recipients via a network (i.e. Internet), (abstract and paragraph [0004], lines 1-13). Specifically, Sykes discloses the third party archiving and verification system to comprise:

- The method for registering and certifying an electronic message, the method, (abstract; paragraph [0004], lines 1-13; and paragraph [0038], line 1 to paragraph [0040], line 17), comprising the steps of:
- A client accessing a website and establishing a registration account, (paragraph [0048]; Figures 4-22);
- A processing unit (i.e. third party archiving and verification server; paragraph [0038]) accepting the registration account (i.e. server of provider web page; paragraph [0048]);
- The processing unit assigning a code (i.e. account ID) to the registration account of the client, (paragraph [0048], line 1 to paragraph [0049], line 16 and Figure 4); and
- The client selecting a service request (i.e. user selects confirm email; paragraph [0062], lines 1-4; Figure 21);
- The service request further comprising that the content of the client's electronic message be verified by the processing unit, (i.e. notary verifies correct; paragraph [0051]);
- The processing unit receiving the client's service request, (i.e. system receives email; paragraph [0062], lines 4-7; Figure 21);
- The processing unit verifying the content of the electronic message, (i.e. notary verifies correct; paragraph [0051]);

- The processing unit sending the electronic email message to the intended recipient as identified by the client in the registration account, (i.e. system delivers the email to recipients inbox; paragraph [0062], lines 8-19; Figure 22)
- The processing recipient choosing whether or not to post a reply for the client with the processing unit, the processing unit accepting the reply, if posted (paragraph [0043], line 1 to paragraph [0044], line 17; Figure 26);
- The processing unit creating a confirmation record (i.e. message table entry) (paragraph [0038], line 1 to [0047], line 12; paragraph [0059], line 1 to paragraph [0061], line 8; and paragraph [0065], lines 9-13; Figure 26).

Although Sykes discloses substantial features of the claimed invention, the reference fails to show the processing unit creating a digital certificate containing the information of the confirmation of the confirmation record; the processing unit archiving the digital certificate information; and the processing unit sending the client the digital certificate. Nonetheless, digital certificates were well known in the art at the time of the invention, as further evidenced by Byrd. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to accordingly modify the method as disclosed by Sykes.

In an analogous art, Byrd discloses a method for validating electronic messages in order to prevent tampering, (abstract). Byrd further discloses the message validating method comprises a processing unit creating a digital certificate containing the information of the confirmation of the confirmation record (i.e. user's digital certificate issued by authority; column 3, lines 35-48; Figure 3-items 401, 407); the processing unit

archiving the digital certificate information (i.e. database stores digital certificate; column 3, lines 35-58); and the processing unit sending the client the digital certificate (i.e. return receipt; Figure 5-item 505; column 4, lines 19-22). One of ordinary skill in the art would have been motivated to implement the digital certificate in the aforementioned method of Sykes, so as to further validate transmission by encoding electronic messages for protection against tampering of content (Byrd column 2, lines 19-33). Although Sykes and Byrd disclose substantial features of the claimed invention, the reference fails to explicitly disclose the method comprising: a service request further comprising that the client's identity be withheld from the intended recipient; the processing unit resending the electronic message to the intended recipient as identified by the client in the registration account; the processing unit notifying the intended recipient that the electronic message has been sent on behalf of the client by the processing unit. Nonetheless, these features would have been obvious modifications to the aforementioned method, as disclosed by Sykes and Byrd, for one of ordinary skill in the art at the time of the invention, as further evidenced by Epstein.

In an analogous art, Epstein discloses a method of secure and anonymous electronic messaging via a public network (abstract). Epstein expressly discloses the well know use of an anonymous remailer which provides: service request comprising that the client's identity be withheld from the intended recipient; the processing unit resending the electronic message to the intended recipient as identified by the client in the registration account; the processing unit notifying the intended recipient that the electronic message has been sent on behalf of the client by the processing unit (column

1, lines 45-62). These modifications to the aforementioned method, as disclosed by Sykes and Byrd, would have been obvious to one of ordinary skill in the art because one would have been so motivated to facilitate “bi-directional e-mail communication over a network without compromising the sender’s identify”, and thereby increasing user privacy, (Gabber column 2, lines 1-5).

In reference to claims 47 and 51, Epstein shows the method whereby the processing unit clearly identifies a constant and verifiable email address of the processing unit and verifiable contact information of the processing unit, in the email to the intended recipient, (i.e. header information which points back to the remailer; column 1, lines 45-62).

In reference to claims 48 and 52, Epstein shows the method whereby the intended recipient is notified that the intended recipient may choose to post a reply with the processing unit for the originator of the electronic message, (i.e. remailer retains the source address of message originators for replies to be forwarded, column 1, lines 45-62).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/LaShanya R Nash/  
Examiner, Art Unit 2153  
June 2, 2008

/Glenton B. Burgess/  
Supervisory Patent Examiner, Art  
Unit 2153

